

Application Serial No.: 09/867,402
Reply to Office Action dated January 29, 2003

REMARKS

Favorable reconsideration of this application as presently amended and in light of the following discussion is respectfully requested.

Claims 1, 3-17, 19-37, and 39-42 are presently active in this case, Claims 1, 4, 5, 20, 21, 23-25, 32, 40, and 41 having been amended and Claims 18 and 38 having been canceled without prejudice or disclaimer by way of the present Amendment. Claim 2 was previously canceled without prejudice or disclaimer.

The Applicants wish to thank Examiner Wai Sing Louie for the courtesies extended to Applicants' representative, Christopher Ward, during the personal interview.

In the outstanding Official Action, Claims 1, 3, 6-17, and 22 were rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention. The Official Action indicates that the optical system mounting member (5) is "in contact" with the temperature control device (25) because the optical system mounting member (5) is in contact with the base (2) (presumably this is referring to the laser diode mounting member (8)), which is in contact with the temperature control device (25). Firstly, the Applicants note that the base (2) is defined on page 9, paragraph 0045, of the originally filed specification, as including the laser diode mounting member (8) and the holder mounting member or optical system mounting member (5). Thus, contact with the base (2) does not necessarily mean contact with the optical system mounting member (5), since the optical system mounting member is merely one portion of the feature defined as the base (2). Secondly, it appears as though the term "contact" is being interpreted to encompass a situation in which a first object touches a

Application Serial No.: 09/867,402
Reply to Office Action dated January 29, 2003

second object, and the second object touches a third object, thereby the Official Action concludes that the first object is "in contact with" the third object. The Applicants submit that this is an incorrect interpretation of the word "contact." Webster's II New College Dictionary defines the word "contact" as "the touching of two objects or surfaces." Clearly, in the above example, the first object does not touch the third object. However, in order to expedite the prosecution of the present application, the Applicants have amended Claims 1 and 23 in a non-narrowing manner to change "contact" to "direct contact" in order to resolve this issue. Therefore, the Applicants respectfully submit that the present application clearly provides support for the limitation "wherein said optical system mounting member is not in direct contact with said temperature control device." As can clearly be seen in Figure 1 of the present application, the non-limiting embodiment depicted therein includes an optical system mounting member (5) that is not in direct contact with the temperature control device (25), since the laser diode mounting member (8) is provided therebetween. Accordingly, the Applicants respectfully request the withdrawal of the rejection under 35 U.S.C. 112, first paragraph.

Claims 1, 3, 6-14, 19, 22-23, 26-29, 31, 33-34, 39, and 42 were rejected under 35 U.S.C. 102(b) as being anticipated by Yoshino (U.S. Patent No. 5,924,290). Claims 4-5, 15, 20-21, 24-25, 32, and 40-41 were rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshino. Claims 18, 30, and 38 were rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshino in view of Shimaoka et al. (U.S. Patent No. 5,195,155). Claims 16-17 and 35-37 were rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshino in view of Miki et al. (U.S. Patent No. 6,094,515). For the reasons discussed below, the Applicants request the withdrawal of the art rejections.

Application Serial No.: 09/867,402
Reply to Office Action dated January 29, 2003

The Applicant submits that a *prima facie* case of obviousness has not been established in the present case because the cited reference does not teach or suggest all of the claim limitations.

Claim 1 of the present application recites a laser diode module comprising, among other features, an optical system mounting member configured to support at least a portion of an optical system, and a temperature control device thermally connected to a laser diode by a laser diode mounting member, wherein the optical system mounting member is not in direct contact with the temperature control device. Claim 23 of the present application recites a semiconductor laser diode module comprising, among other features, a fastening means for supporting at least a portion of an optical system, and a temperature control device thermally connected to a laser diode by a laser diode mounting member, wherein the fastening means mounting member is not in direct contact with the temperature control device. The Applicants submit that the cited references do not teach all of the limitations recited in Claims 1 and 23.

As discussed during the personal interview, Claim 1 recites that the optical system mounting member is not in direct contact with the temperature control device, and Claim 23 recites that the fastening means mounting member is not in direct contact with the temperature control device, which are not disclosed in the Yoshino reference cited against these claims. The Yoshino reference describes and depicts a lens holder (11) that is in direct contact with a Peltier unit (6), as shown in Figure 2 and 4. The Yoshino reference states that "[t]he lens holder 11 ... is mounted on the upper place 6c of the Peltier unit 6..." (See column 6, lines 6-8, of the Yoshino reference.) Accordingly, the Yoshino reference does not disclose all of the limitations recited in independent Claims 1 and 23, and, furthermore, the

Application Serial No.: 09/867,402
Reply to Office Action dated January 29, 2003

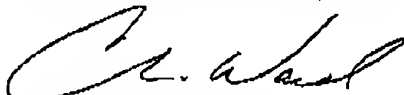
Yoshino reference does not provide any motivation for or suggestion of a modification of the invention described therein which would result in the present invention. Thus, the Applicants respectfully request the withdrawal of the art rejections of Claims 1 and 23.

Claims 3-17, 19-22, 24-37, and 39-42 are considered allowable for the reasons advanced for Claims 1 and 23 from which they depend. These claims are further considered allowable as they recite other features of the invention that are neither disclosed, taught, nor suggested by the applied references when those features are considered within the context of Claims 1 and 23.

Consequently, in view of the above discussion, it is respectfully submitted that the present application is in condition for formal allowance and an early and favorable reconsideration of this application is therefore requested.

Respectfully Submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Bradley D. Lytle
Registration No. 40,073
Attorney of Record
Christopher D. Ward
Registration No. 41,367



22850

Customer Number 22850
Tel. (703) 413-3000
Fax. (703) 413-2220
(OSMMN 10/01)

BDL:CDW:tdm
I:\ATTY\CDW\205471US\AM2.DOC